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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|-------------|----------------------|---------------------|
|-----------------|-------------|----------------------|---------------------|

09/475, 703 12/30/99 SLUSAREK

W 78738EAR

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IM52/0702

EXAMINER

|         |          |              |
|---------|----------|--------------|
| CHEA, T | ART UNIT | PAPER NUMBER |
|---------|----------|--------------|

8

1752  
DATE MAILED:

07/02/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

|                              |                        |                  |
|------------------------------|------------------------|------------------|
| <b>Office Action Summary</b> | Applicant No.          | Applicant(s)     |
|                              | 09/475,703             | SLUSAREK ET AL.  |
|                              | Examiner<br>Thorl Chea | Art Unit<br>1752 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 16 April 2001.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-5 and 7-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,2,7-10 and 14-20 is/are rejected.
- 7) Claim(s) 3-5, 11-13 is/are objected to.
- 8) Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

- |   |  |
|---|--|
| 15) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 18) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 16) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 19) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 17) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 20) <input type="checkbox"/> Other: _____                                    |

Art Unit: 1752

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The terms X' and Y' for the structure II are not defined.

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-2, 7-10, 14-20 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The wet developable developing art such as conventional photographic art and dry silver material known as thermally developable material has been known as distinct art. The ingredients useful in the photographic art may not useful in the photothermographic or thermographic art. The photothermographic material, photothermographic material, and thermographic material are distinct in term of its composition and its used in image formation. The PUG presented in the specification such as coupler, development inhibitor, bleach accelerator, bleach inhibitor, inhibitor

✓ Art Unit: 1752

releasing developer, dye precursor, developing agent, silver ion fixing agent, electron transfer agent, silver halide solvent, halide complexing agent, reductone, image toner, pre-processing or post-processing image stabilizer, hardener, tanning agent, fogging agent, ultraviolet absorber, nucleating, chemical or spectral sensitizer, desensitizer, surfactant, or precursor are not useful in all photographic material, photothermographic material and thermographic material. The additives which are useful in the photographic material are not useful in photothermographic or thermographic material. The specification for instance fails to clearly describes as how to use the chemical sensitizer, spectral sensitizer, desensitizer precursor, pre-processing stabilizer, post-processing stabilizer, ultraviolet absorber or coupler in the thermographic material. The selection of photographic useful groups suitable for the photographic, photothermographic and theremographic material is not clearly described in the specification. Thus, the specification fails to describe the invention in such a way as to reasonably convey to one skilled in the relevant art, (i.e. photographic, photothermographic and thermographic), that the inventor(s), at the time the application was filed, had possession of the claimed invention

1. Claims 1-2, 7-10, 14-20 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for blocked developer of formula () on page 16 wherein PUG is a developer, does not reasonably provide enablement for compound of formula in claim 1 having PUG wihin the meaning of photographic useful group. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention

✓ Art Unit: 1752

commensurate in scope with these claims. The term "photographic useful group" has been known in the art as a group useful in the wet-developable material such as conventional photographic material. The photothermographic and thermographic material has been known as heat sensitive material. The PUG (photographically useful group) may limit to the use in the conventional silver halide photographic material, but not to the photothermographic or thermographic material. Moreover, the specification shows only a block developer that useful in photographic, photothermographic and thermographic material.

2. Claims 3-5, 11-13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

3. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 1752

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thorl Chea whose telephone number is (703)308-3498.

The examiner can normally be reached on M-F (9:30 - 6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet C Baxter can be reached on (703)308-2303. The fax phone numbers for the organization where this application or proceeding is assigned are (703)305-3599 for regular communications and (703)305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

  
Thorl Chea  
Primary Examiner  
Art Unit 1752

tchea   
July 1, 2001